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First Named Applicant: DaCosta)	Art Unit: 2614
)	
Serial No.: 10/782,265)	Examiner: Beliveau
)	
Filed: February 19, 2004)	50T5776
)	
For: SYSTEM AND METHOD FOR PROVIDING)	October 22, 2006
CONTENT LIST IN RESPONSE TO SELECTED)	750 B STREET, Suite 3120
CLOSED CAPTION WORD)	San Diego, CA 92101
)	

RESPONSE TO Board Decision

Commissioner of Patents and Trademarks
Washington, DC 20231

Dear Sir:

This responds to the Board decision rendered September 28, 2006, reversing the examiner *in toto* and rejecting Claim 1 under 35 U.S.C. §102 as being anticipated by Yen et al., USPN 5,991,799. Although for reasons below Applicant believes that the Board has mistakenly found a claimed element in Yen et al. that is not there, in the interest of complete examination and to give the examiner the opportunity to consider Yen et al. and the remaining claims, prosecution is hereby reopened.

Applicant largely concurs with the Board's findings concerning Yen et al. with an important exception. The Board correctly notes that in Yen et al., col. 11, lines 4-16, a hypertext link to a web site can be displayed in closed captioning, but nowhere does the Board point to any teaching in Yen et al. that this hyperlink appears differently than other closed captioning text by virtue of, e.g., being underlined, italicized, bolded, having a different font size or color, or by flashing. Instead, the Board, after never having

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mentioned the "appears differently" limitation in the preceding discussions of various parts of Yen et al., inconsistently concludes on page 12, lines 15-18 of the decision, without citing any part of Yen et al., that "as described above, Yen teaches the claimed primary words within the closed captioning text as the hypertext link which appears differently from the secondary words" despite the fact that this conclusion is belied by the fact that the Board never pointed to any "appears differently" teaching in Yen et al. in the discussion preceding its conclusion. Indeed, Applicant can find no such teaching in Yen et al.

Accordingly, having failed to point to a specific part of Yen et al. for its conclusion, the Board's position as to just why, precisely, it thinks that the hyperlinks (composed of alpha-numeric characters) in Yen et al. are presented any differently in closed captioning than remaining alpha-numeric text is difficult to fathom, particularly in light of the fact that the Board considered and rejected the "dog/cat" hypothesis underpinning the previous rejections. A hyperlink is simply text, e.g., www.uspto.gov, that indeed is spelled differently than other text but otherwise does not appear differently - unless more is done to it than Yen et al. discloses - in accordance with the logic of Applicant's prior arguments with which the Board agreed in reversing the previous rejections.

In addition to the above, Applicant notes that the Board agreed that no convincing rationale had been identified to combine various references together, nor did the Board address the specific "flashing" limitation of Claim 10 in the context of Yen et al., which indeed does not teach it and which presumably would remain patentable even were Yen et al. to be combined with IBM-TB for reasons set forth in the Decision.


The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

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Respectfully submitted,



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